

### **Remarks/Arguments**

Reconsideration of this application, as amended, is respectfully requested.

#### **I. Status of the Claims**

Claims 1-59 and 64-66 are pending. Claims 60-63 and 67-71 are canceled.

Claims 1, 5, 27, 33, 37, 48, 51 and 55 are amended to limit the claims to compounds wherein A is  $(CH_2)_q$ , q is 2, m and n are both 1, and o and p are both 0, thereby cancelling the non-elected subject matter.

Claims 1, 2, 5 and 8 are amended to delete hydrogen from the possible  $R^2$  groups.

Claim 1 is also amended to include a proviso which was inadvertently dropped from claim 1 as reprinted in the preliminary amendment filed June 29, 2004.

Claims 2, 3, 56, 59 and 66 are amended to correct informalities.

No new matter is added by these amendments.

#### **II. Restriction Requirement and Lack of Unity of Invention**

In a telephone restriction requirement in February 2006, the Examiner had required restriction among one of eight claim groups. In a telephone conference dated February 15, 2006, the undersigned had elected prosecution of the Group I claims, wherein A is  $(CH_2)_q$ , q is 2, and p and o are 0, and m and n are 1, and elected the species of Example 1 at pages 53-54. Applicants now confirm the election, and cancel the non-elected subject matter.

The Examiner is now requested to withdraw the restriction requirement.

#### **III. Rejections Under 35 U.S.C. § 101**

Claims 68 and 70 are rejected under 35 U.S.C. § 101, on the grounds that the claims recite a use without setting forth any steps. Claims 68 and 70 were canceled in the preliminary amendment, filed June 29, 2004. In view of the foregoing, it is requested that the rejections be withdrawn.

#### **IV. Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 3, 4, 56, 66 and 67 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

Claims 3 and 4 are rejected because of multiple references to a variable as defined in claim 1,

Claims 3 and 4 are amended to remove the multiple references.

Claim 56 is rejected because of an error in dependency, and has been amended to correct the error.

Claim 66 is amended at the request of the Examiner to recite "a therapeutically effective amount."

Claim 67 was canceled in the preliminary amendment, filed June 29, 2004, thereby obviating the rejection.

In view of the foregoing, it is believed that the rejections under 35 U.S.C. § 112 have been overcome. It is requested that the rejections be withdrawn.

**V. Rejections Under U.S.C. § 112, First Paragraph**

At pages 6-7 of the office action, claims 69 and 71 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking written description. At pages 8-16 of the office action, claims 69 and 71 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement.

Claims 69 and 71 have been canceled, thereby obviating the rejections under 35 U.S.C. § 112, first paragraph.

In view of the foregoing, it is believed that the rejections under 35 U.S.C. § 112, first paragraph, have been overcome. It is requested that the rejections be withdrawn.

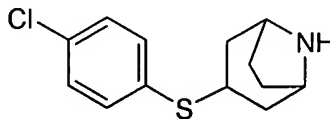
**VI. Double Patenting Objection**

Claim 67 is objected to as a substantial duplicate of claims 1-65 or 66. Claim 67 was canceled in the preliminary amendment filed June 29, 2004, thereby obviating the objection. It is requested that the objection be withdrawn.

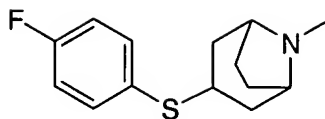
**VII. Rejections Under 35 U.S.C. § 102**

Claims 1, 5 and 6 are rejected under 35 U.S.C. § 102, as anticipated by:

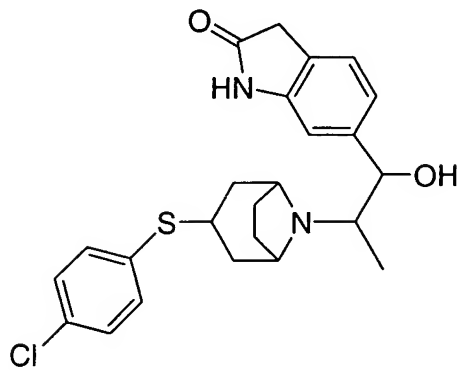
(1) WO 96/37226, Example 14 at page 43, and U.S. Patent No. 6,046,213, preparation 41, at column 51, which is:



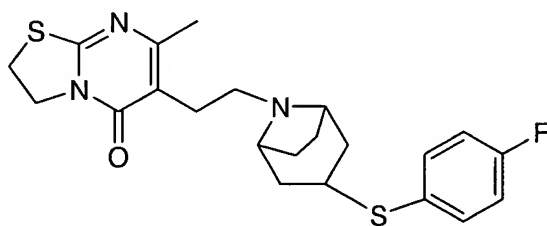
(2) U.S. Patent No. 6,046,213, preparation 36, at column 49, which is:



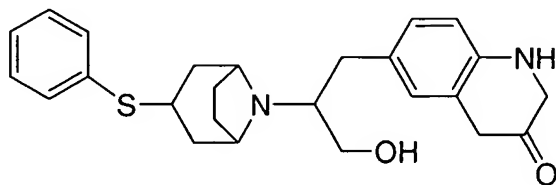
(3) U.S. Patent No. 5,498,610, Example 13, at column 11, which is



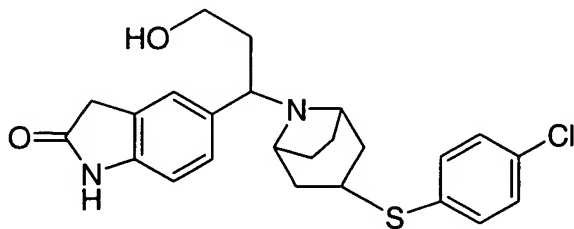
(4) JP 04054181, compound 204, at page 673, which is



(5) U.S. Patent No. 5,306,723, Example 14, at column 11, which is:



(6) U.S. Patent No. 5,306,723, Example 13, at column 10, which is:



Applicants respectfully traverse the rejections, on the grounds that there are structural differences between the compounds disclosed in the prior art and the claimed compounds. Each of the compounds (1) to (6) depicted above have a hydrogen or halogen at the position corresponding to R<sup>2</sup> in the claims. In contrast, the claims as now amended permit neither hydrogen nor halogen at R<sup>2</sup>.

In order for a prior art reference to anticipate a claimed invention, the reference must disclose "either expressly or inherently, every limitation of the claim[,] . . . [and] [a]bsence from the reference of any claimed element negates anticipation." *Rowe v. Dror*, 42 USPQ2d 1551, 1553 (Fed. Cir. 1997). Here, the cited compounds lack the claimed substitution at the R<sup>2</sup> position. Accordingly, the cited disclosure does not anticipate the claims.

In view of the action taken and arguments made, it is believed that the anticipation rejection has been overcome. It is respectfully requested that the rejection be withdrawn.

**VIII. Claim Objections**

Claims 2, 7, 19-22, 30 and 4-55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

The Examiner is directed to the amendments herein. In view of the action taken and arguments made, it is believed that all pending claims are now in condition for allowance.

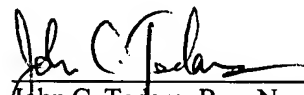
**IX. Conclusion**

In view of the actions taken and arguments made, it is believed that all pending claims 1-59 and 64-66 are now in condition for allowance.

Favorable action is earnestly solicited.

Respectfully submitted,

By

  
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